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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/249,660	02/12/1999	YUKIHISA NAKAJO	P 245595	1181

7590 07/29/2005

Pillsbury Winthrop LLP  
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725 South Figueroa Street, Suite 2800  
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EXAMINER
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PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/249,660	NAKAJO, YUKIHISA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Aristotelis M. Psitos	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

Applicant's response of 4/7/05 has been considered with the following results.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 13,15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As previously discloses and presented, the sampling of the te signal is during particular time periods, as described with respect to figure 1. As noted and described, there is a hold period as well, hence the amendments introducing the phrase/concept of.. "repeatedly calculated amount" is interpreted by the examiner as contrary to the disclosure as originally filed.

Again, the te signal is intermittently provided/calculated for because there is a time period in which no calculation is performed, rather a calculated value is HELD.

Because all the claims recite such concept/phraseology they are all rejected accordingly.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Applicant's argues that support for such terminology exists in the specification and the figures. Although the exact phrase need not appear (except required by 37 CFR 1.75 (d) (1)), the examiner cannot readily find support for such amendment/terminology. The examiner hereby requests applicants' cooperation in indicating where such terminology is either explicitly found, or alternatively where such terminology would logically follows.

As far as the claims are interpreted, the following rejections are made.

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**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 13, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eastman et al further considered with Watanabe, or alternatively Eastman et al further considered with Watanabe and both further considered with Abate et al.

The following claim analysis is made:

Claim 13.

Eastman et al

An optical disk method for recording

abstract/title

information on an optical disk,

record info. On an optical

based on a mark-length recording scheme, comprising:

disc

forming pits sequentially from an inner

pits are formed, no

circumference to an outer circumference of the

directional indication

optical disk by a light beam irradiated onto a track formed as a

see secondary ref.

groove or land on a recording surface of the optical disk; and

to Watanabe et al

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figure 5

performing tracking control, while forming said

pits, by offsetting a center of an optical axis of the light beam, see column 2, ones 46-61

by a repeatedly calculated amount, from a center line of in Eastman, and col. 6

the track toward the outer circumference of the optical disk, lines 12-22 in Abate et al

circumference of the optical disk, the repeatedly calculated

amount being such that pit forming efficiencies of the inner

and outer circumference sides of the track

relative to the light beam are balanced.

In the above analysis, the base reference to Eastman et al discloses in this environment, the ability of recording optical information and performing tracking control. The examiner interprets the tracking control to be while information is being written to the disc.

Furthermore, the examiner interprets the above passage in Eastman et al to describe a "dynamic" tes and hence the error signal is by necessity "repeatedly" calculated.

There is no clear depiction of the radial direction of such writing.

Watanabe et al teaches in this environment, the additional ability of writing from the inner to the outer circumference and performing the appropriate tes and correction capability.

It would have been obvious to modify the base system of Eastman et al with the above teaching from Watanabe et al, motivation is to provide for a systematic (id to od inner diameter – to outer diameter) Recording process while repeatedly performing the tes calculations and corrections as required by the claims.

If applicant can convince the examiner that such is not present, i.e., the repeatedly calculation, then the examiner further relies upon the Abate et al system – see the description as found in col. 6 lines 12-22 describing a tes "on the fly". It would have been obvious to modify the base system of Eastman et al/Watanabe with the above noted "on the fly" tes calculation, motivation is to perform the tes as required for proper track following/centering.

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With respect to method claims 17 and 19, the same analysis is made with respect to its claimed limitations.

### **Conclusion**

With respect to claims 15, 16, 18 and 20, if the above 112 rejection could be overcome, then these claims would be allowable over the art of record.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Aristotelis M Psitos  
Primary Examiner  
Art Unit 2653

A handwritten signature in black ink, consisting of a series of loops and a long, sweeping stroke that extends downwards and to the left.

AMP